UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,336	01/24/2000	Jeffry Jovan Philyaw	PHLY-24.896	7014

			EXAMINER
25883	7590	02/20/2004	NGUYEN, THANH T

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ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/490,336	PHILYAW, JEFFRY JOVAN
		Examiner	Art Unit
		Tammy T Nguyen	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *(3)* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 December 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9 and 19-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9 and 19-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>24 January 2000</u> is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

UNITED STATES PATENT AND TRADEMARK OFFICE

Detailed Office Action

1. This action is in response to the amendment filed December 4, 2003.

2. Claims 10-18 are cancelled.

3. Claims 1-9, and 19-28 are pending.

Response to Arguments

4. Applicant's arguments filled on December 4, 2003 have been fully considered, however they are not persuasive because of the following reasons:

5. Applicants argue that Hudetz does not teach any way of operating a first application program with a pointing device that has the ability to both optically scan information. In response to Applicant's argument, the Patent Office maintain the rejection because Hudetz does teach a first application program with a pointing device that has ability to optically scan information shown as col.5, lines 25-29. Clearly show that a pointing device has to have a application program in order to have ability to optically scan information, otherwise that device can not work or function.

6. Applicants argue that neither Hudetz et al nor Chiu et al teach providing a foreground application program that utilizes the mouse and a background program utilizing a device with scanner. In response to Applicant's argument, the Patent Office maintain the rejection because

Chiu teaches providing a foreground application program that utilizes the mouse and a

background program utilizing a device with scanner and mouse function as shown Figure. 1, and

col. 5, lines 10-24. Clearly show that providing a foreground application program that utilizes

the mouse and background program utilizing a device with scanner.

7. In response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., provide a

mouse, and mouse function) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Therefore, the Examiner asserts that cited prior arts teach or suggest the subject matter

broadly recited in independent claims 1, and 19. Claims 2-9, and 20-28 are also rejected at least

by the virtue of their dependency on independent claims and by other reasons set forth in the

previous office action [see paper no. 15].

9. Accordingly, claims 1-9, and 19-28 are respectfully rejected.

Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all   ,

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al., (hereinafter Hudetz) U.S. Patent No. 5,978,773 in view of Chiu et al., (hereinafter Chiu) U.S. Patent No. 5,35,146.

12. As to claim 1, Hudetz teaches the invention as claimed, including a method of obtaining product information regarding a product, comprising the steps of:

disposing a first computer of a user on a network that is operable to run an application program in the foreground and a product information access program in the background; (Abstract, col.1, lines 20-55);

connecting an input device to the first computer to provide a user interface to the first computer, wherein the input device can sense both position data of and external surface that is related to an optical indicator on a user display associated with the first computer to indicate the relative position of the input device to the external surface when the first program is running in the foreground, and detect optional indicia of the product, from displayed indicia on an external optical indicia surface containing a product ID (col.6, lines 8-55, col.5, lines 13-34, and col.10, lines 3-27);

detecting with the input device the optical indicia of the product on the external optical indicia surface (col.5, lines 36-40);

the product information access program operable to access a second computer disposed on the network in response to the detection of the optical indicia of the product with the input device (col.3, lines 16-57, col.12, lines 11-67, col.6, lines 8-33, col.7, lines 2-28, col.8, lines12-20);

performing a lookup operation at the second computer to match the product ID with routing information of each of a plurality of vendor servers disposed on the network, the vendor servers

having unique product-related information of the product (col.8, lines 12-67, and col.9, lines 1-5);

returning the routing information of the vendor severs from the second computer to the first

computer in order to access the vendor server (col.8, lines 11-63); and

accessing the vendor server in accordance with the routing information to return the product-

related information to the first computer for simultaneous presentation to the user on the display

(col.1, lines 21-63, and col.8, lines 29-67).

Hudetz does not teach sensing positional data of an external surface that is related to an optical

indicator on a user display to indicate the relative position of the input device to the external

surface. However, Chiu teaches an external surface that is related to an optical indicator on a

user display to indicate the relative position of the input device to the external surface (col. 15,

line 65 to col.16, line 15, col.1, lines 39-50 and col.2, lines 16-43). It would have been obvious

to one of ordinary skill in the Data Processing art at the time of the invention to combine the

teachings of Hudetz and Chiu to have an external surface that is related to an optical indicator on

a user display to indicate the relative position of the input device to the external surface including

in a communication system because it would have an efficient system that can provide specific

functions that dependent upon external conditions for its specific nature or interconnected with

something else.

13. As to claim 2, Hudetz teaches the invention as claimed, wherein the step of accessing the

vendor servers includes respectively accessing a distributor node of the input device, an

advertiser node, and an E-commerce node (col.12, lines 10-60, and col.13, lines 5-51).

14. As to claim 3, Hudetz teaches the invention as claimed, wherein the input device can

sense information stored in magnetic medium (col.6, lines 1-25, and col.12, lines 1-55).

15. As to claim 4, Hudetz teaches the invention as claimed, wherein the step of accessing the Vendor server further comprises the steps of,

returning the product information of the product respectively from an advertiser node, distributor information of a distributor of the input device from a distributor node, and E-commerce information from an E-commerce node (col.8, lines 11-20, and col.1, lines 24-37), and

framing separately the distributor information, product information, and E-commerce information in a browser window of the first computer for presentation to the user (col.11, lines 1-8, col.8, lines 29-63, and col.9, lines 5-13).

16. As to claim 5, Hudetz teaches the invention as claimed, wherein in response to receiving scanned indicia and positional data from the input device, a software interface running on the first computer converts the received indicia data and generates the routing information for transmission to the second computer (col.11, lines 20-60).

17. As to claim 6, Hudetz teaches the invention as claimed, wherein the routing information includes an input device ID and a network address of the second computer (col.5, lines 13-34).

18. As to claim 7, Hudetz teaches the invention as claimed, wherein the user enables reading of the indicia, in the step of connecting, by first depressing one or more buttons on the input device (col.3, lines 45-57, and col.3, lines 4-15).

19. As to claim 8, Hudetz teaches the invention as claimed, wherein a software interface

running on the first computer is operable to automatically detect reading of the product indicia

by the input device and detect positional data (col.3, lines 24-67, and col.11, line 62 to col.12,

line 9).

20. As to claim 9, Hudetz teaches the invention as claimed, wherein the input device and a

software interface running on the first computer perform a handshake operation using a unique

input device ID stored in the input device prior to enabling operation of one or more operating

modes of the input device (col.5, line 13-34, and col.8, lines 29-46).

21. As to claim 19, Hudetz teaches the invention as claimed, including a method for

connecting two locations on a network utilizing a pointing device at the first location

interconnected to a user's computer at the first location, comprising the steps of:

providing both positional and optical scanning capabilities in the pointing device (col.11,

lines 1-61, col.10, lines 3-54, and col.2, lines 1-25);

scanning the pointing device with the optical scanning capability thereof over an encoded

optical code, encoded with information representative of a location on the network of a second

location, while operating a first program on the user computer which utilizes the positional

capabilities of the pointing device of external surface that is related to an optical indicator on a

user display to indicate the relative position of the input device to the internal surface during

running of the first program;(col.6, lines 5-65, col.8, lines 10-67, and col.12, lines 5-55);

running a second program in the user's computer (col.2, lines 5-65 and col.8, lines 1-65);

detecting with the second program the scanning of the encoded optical code by the pointing

device (col.3 lines 1-60);

connecting with the second program the first location to each of a plurality of the second

locations to over the network through respective routing location indicated by the information

encoded in encoded optical codes in response to the step of detecting the encoded optical code

(col.11, lines 28-39, col.5, lines 1-25, and col.19, lines 12-21); and

receiving information from each of the second location transmitted there from to the first

location for simultaneous display thereof on the display (col.8, lines 5-65).

Hudetz does not teach sensing positional data of an external surface that is related to an optical

indicator on a user display to indicate the relative position of the input device to the external

surface. However, Chiu teaches an external surface that is related to an optical indicator on a

user display to indicate the relative position of the input device to the external surface (col. 15,

line 65 to col.16, line 15, col.1, lines 39-50 and col.2, lines 16-43). It would have been obvious

to one of ordinary skill in the Data Processing art at the time of the invention to combine the

teachings of Hudetz and Chiu to have an external surface that is related to an optical indicator on

a user display to indicate the relative position of the input device to the external surface including

in a communication system because it would have an efficient system that can provide specific

functions that dependent upon external conditions for its specific nature or interconnected with

something else.

22. As to claim 20, Hudetz teaches the invention as claimed, wherein the encoded optical

code is a barcode (col.11, line 62 to col.12, line 21).

23. As to claim 21, Hudetz teaches the invention as claimed, wherein the encoded optical

code is an ISBN code (col.5, lines 5-65, and col.10, lines 1- 36).

24. As to claim 22, Hudetz teaches the invention as claimed, wherein the encoded optical

code is an EAN code (col.10 lines 1-20, col.12, lines 2-65, and col.13, lines 25-50).

25. As to claim 23, Hudetz teaches the invention as claimed, wherein the encoded optical code is disposed on a flat surface (col.1, lines 20-60, and col.9, lines 20-60).

26. As to claim 24, Hudetz teaches the invention as claimed, wherein the encoded optical code is disposed on a product (col.3, lines 15-60).

27. As to claim 25, Hudetz teaches the invention as claimed, wherein the encoded optical code is encoded with information regarding the product and associated with a product (col.9, lines 10-67, and col.3, lines 1-55).

28. As to claim 26, Hudetz teaches the invention as claimed, wherein the step of receiving Information comprises displaying the information received from the second location when received there from (col.11, lines 1-20, and col.4, lines 15-60).

29. As to claim 27, Hudetz teaches the invention as claimed, wherein the step of connecting includes the step of watching a web browser program which is operable to interface with the network (col.2, lines 7-36).

30. As to claim 28, Hudetz teaches the invention as claimed, wherein the step of connecting comprises:

assembling a packet of data with the information extracted from the encoded optical code contained therein (col.14, lines 1-25);

transferring the assembled packet to an intermediate network location remote from the first location (col.2, lines 1-20);

providing at the intermediate location a database having contained therein a plurality of

routing addresses on the network and corresponding encoded optical information(col.1, lines 1-

20, and col.11, lines 1-60);

comparing the information disposed in the received packet at the intermediate location

with information in the database to determine if there is at least one corresponding routing

address disposed therein corresponding with the encoded optical information (col.7, line 43 to

col.8, line 10, col.11, lines 28-39);

if a match exists, then returning the matching information in the form of the routing

address to the first location (col.7, lines 28-42, col.8, line 47 to col.9, line 4); and

connecting the first location to each of a plurality the second location in accordance with

the network address information returned thereto from the intermediate location (col.2, lines 16-

27, and col.3, lines 24-44).

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

32. Any inquiries concerning this communication or earlier communications from the

examiner should be directed to **Tammy T. Nguyen** who may be reached via telephone at

(703) 305-7982. The examiner can normally be reached Monday through Friday between

8:00 a.m. and 4:30 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding this instant

application, please send it to **(703) 872-9306**. If attempts to reach the examiner by telephone are

unsuccessful, the Examiner's Supervisor, **David Wiley**, may be reached at **(703) 308-5221**.

TTN
February 9, 2004

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100